

Appl. No. 10/775,764  
Atty Docket: ZK524-03151  
Inventor: Bernhart *et al.*

### REMARKS

Reconsideration of the above referenced application is respectfully requested. Claims 1-28 remain in the pending application.

#### **35 U.S.C. § 103(a) Rejection of Claims**

The Examiner has rejected Claims 1, 8-10, 12-15 under 35 U.S.C. § 103(a) as being unpatentable over Usher *et al.* and in further view of Crane. Applicants' attorney respectfully traverses the Examiner's rejection.

The Examiner alleges that Usher *et al.* discloses all of the claimed invention except for the recitation of a channel having at least one air-handling slot. The Examiner further alleges that Crane discloses an air-handling luminaire having a channel having at least one air-handling slot located in the upper surface of the channel, and ceiling brackets fastened to the side of the channels. Therefore, the Examiner alleges, it would have been obvious to one in ordinary skill in the art at the time the invention was made to implement an air-handling fixture as taught by the air-handling luminaire Crane into the device of Usher *et al.* since as taught by Crane, air-handling component, channels and vents in fluid communication with each other in a luminaire are purposeful for providing light emitting structure with a cooling means to prevent burning of the illumination housing.

First, Applicants' attorney takes exception with the Examiner's allegation. Specifically, the Examiner alleges that "air-handling component, channels and vents in fluid communication

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with each other in a luminaire are purposeful for providing light emitting structure with a cooling means to prevent burning of the illumination housing.” To the contrary, the Crane reference fails to teach any function related to light emitting structure with cooling means to prevent burning of the illumination housing. Instead, the Crane reference teaches a luminaire having air handling capability and which includes a plastic inlay which is released during fire conditions to inhibit spread of fire through a building. See Col. 1, ll. 32-37. Moreover, the Usher *et al.* reference also fails to provide a the function or structure alleged by the Examiner. Instead, the Usher *et al.* reference only teaches a lighting apparatus which eliminated the need for use of a fixture. Thus the cited references alone fail to teach the function alleged by the Examiner.

Also contrary to the Examiner’s allegations, Applicants’ instant invention is not rendered obvious by the combination of Usher *et al.* and Crane for at least two reasons. First, as stated in MPEP 2143.01 the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916F.2d 680 (Fed. Cir. 1990). The cited prior art in the instant rejection, provides no suggestion for the Examiner’s combination of references. The Usher *et al.* reference teaches a miniature lighting apparatus. The miniature lighting apparatus allows repositioning/directing of lights by moving the light. The lamp unit is directly pluggable into the mounting track which eliminates the “cumbersome intervening fixture,” as recited in the specification at Col. 2, ll. 9-10. In fact, one of the objects of the Usher *et al.* disclosure is to teach a device which allows for elimination of the conventional fixture. To the contrary, the Crane reference teaches a heat distorting clip for use in an air-handling luminaire. The luminaire comprises a housing or fixture

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for a fluorescent luminaire system. Since the Crane reference teaches the use of a luminaire housing or fixture, it is apparent that the combination of the Usher *et al.* reference and the Crane reference is improper. Again, as stated in the Usher *et al.* specification, one object of that invention is to eliminate the use of a fixture, which is necessary for the Crane invention. Thus, these prior art references, alone or in combination, fail to suggest any desirability for the Examiner's cited combination.

Second, apart from the lack of suggestion to combine, the references teach away from one another. The Examiner is again directed to MPEP § 2143.01 wherein the following is recited: If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gorman*, 733 F.2d 900 (Fed. Cir. 1984). The Examiner has combined Usher *et al.* which teaches a device that eliminates a conventional fixture with Crane which teaches a heat distortable clip for use with an air-handling luminaire having a fixture or housing. Since the Usher *et al.* reference teaches away from the use of a fixture as advantageously not requiring the "cumbersome intervening fixture", the Examiner's combination would render the prior art Usher *et al.* invention as being modified unsatisfactory for its intended purpose. Thus, Applicants' attorney again asserts that since the references teach away from one another, the Examiner's cited combination is improper.

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**Allowable Subject Matter**

Applicants' attorney respectfully acknowledges the allowability of Claims 17-28.

Applicants' attorney further acknowledges the allowability of Claims 2-6, 11 and 16, if rewritten in independent form including all the limitations of the base claim and intervening claims.

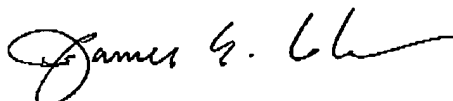
**CONCLUSION**

Applicants' attorney believes that the instant application is now in condition for allowance and therefore respectfully requests that the Examiner withdraw these grounds of rejection. However, if the Examiner believes there are other unresolved issues in this case, Applicants' attorney of record would appreciate a call at (502) 584-1135 to discuss such remaining issues.

DATE: 11/8/05

Respectfully submitted,

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